

REMARKS

The present application includes pending claims 1-20, all of which remain rejected. By this Amendment, claim 18 has been amended to correct a typographical error. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-3, 5-8, 10, 11, 13, 14, 16, and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6,163,817 ("Shteyn"). Claims 4, 9, 12, 15, and 18-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Shteyn in view of United States Patent No. 5,971,397 ("Miguel"). The Applicant respectfully traverses these rejections for at least the reasons previously set forth during prosecution and the following:

I. Shteyn Does Not Render Claims 1-3, 5-8, 10, 11, 13, 14, 16, And 17 Unpatentable

The Applicants first turn to the rejection of claims 1-3, 5-8, 10, 11, 13, 14, 16, and 17 as being unpatentable over Shteyn. In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure (MPEP) states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must **both be found in the prior art, and not based on applicant's disclosure**.

See Manual of Patent Examining Procedure (MPEP) at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

The law is well settled that “obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so.” *ACS Hospital Systems, Inc. v. Montfiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929 (Fed. Cir. 1984). It is not permissible to pick and choose among the individual elements of assorted prior art references to re-create the claimed invention, but rather “some teaching or suggestion in the references to support their use in the particular claimed combination” is needed. *Symbol Technologies, Inc. v. Opticon, Inc.* 935 F.2d 1569, 1576, 19 USPQ2d 1241 (Fed. Cir. 1991).

Additionally, if a *prima facie* case of obviousness is not established, an applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See Manual of Patent Examining Procedure MPEP at § 2142.

A. Shteyn Does Not Teach Or Suggest A Game Subsystem

Shteyn discloses an “information processing system [having] first and second electronic sub-systems, and control means for controlling the sub-systems.” Shteyn at Abstract. In particular, Shteyn “relates to a [sic] information processing system with distributed functionalities. The invention relates, in particular, but not exclusively, to **home theater equipment.**” *Id.* at column 1, lines 7-9. Shteyn lists examples of the sub-systems:

In a home theater environment, sub-systems 102-106 each comprise, for example, any of a one or more display devices, one or more VCR’s, one ore more TV tuners, one

or more radio tuners, one or more audio amplifiers, one or more a (sic) DVD players, a CD jukebox, a digital video camera, a home security system, etc. Alternatively, sub-systems 102-106 each comprise a respective cluster of such pieces of equipment, e.g., organized according to the location of these devices, such as the associated room or building.

Shteyn at column 4, lines 4-12. As shown above, Shteyn lists a whole litany of possible “sub-systems.” Shteyn does not list, however, a “game sub-system,” such as an electronic dart game machine. Notably, neither this passage, nor the remainder, of Shteyn teaches or suggests a game subsystem. There is nothing in Shteyn that even remotely suggests a game sub-system, such as an electronic dart game machine. As noted above, Shteyn discloses a “home entertainment system 100 with a home security sub-system 102” (*id.* at column 5, lines 1-3), and even a “home entertainment system 100 with multiple display devices 102 and 104 and a TV tuner 106” (*id.* at column 5, lines 28-30). Even though Shteyn lists numerous examples of “sub-systems,” **Shteyn never discloses that the sub-system is a game sub-system.** Clearly, if Shteyn had contemplated such a sub-system it would have been listed as an example, considering that Shteyn lists numerous other sub-systems.

B. Shteyn Does Not Disclose That The Subsystem Can Be *Any* Subsystem

The Office Action acknowledges that “Shteyn does not explicitly disclose a game subsystem.” *See* August 23, 2006 Office Action at page 5. In order to overcome this deficiency, however, the Office Action states that “Shteyn teaches that **any** electronic subsystem, including a jukebox or **any** software application can be coupled to a control subsystem (column 2, lines (sic) 34, column 4, line 67).” *See id.* at page 5.

The portion relied on in the Office Action, however, does not teach or suggest that **any** electronic subsystem can be used, and certainly does not teach or suggest a game subsystem. For example, Shteyn discloses the following:

[T]he invention provides an information processing system that comprises first and second electronic sub-systems and control means for controlling at least the first sub-system. At least the first sub-system has a software representation registered with the control means.

Shteyn at column 2, lines 32-36. There is nothing in this passage that teaches or suggests that the electronic sub-system can be **any** electronic sub-system. In fact, there is nothing in Shteyn that states that the sub-system can be **any** electronic sub-system, as the Office Action contends. While Shteyn lists a host of different “sub-systems,” it never once mentions a game sub-system, clearly indicating that electronic game sub-systems, such as electronic dart machine, were never contemplated. Again, if Shteyn had contemplated such a sub-system it would have been listed.

Additionally, Shteyn discloses the following:

FIG 1 is a block diagram of an information processing system 100 in the invention. System 100 comprises a first electronic sub-system 102, a second electronic sub-system 104, a third electronic sub-system 106 and control means 108.

Shteyn at column 3, lines 25-29. Again, however, there is nothing in this passage of Shteyn that teaches or suggests that the sub-systems 102, 104, and 106 can be **any** electronic sub-system.

The Office Action states the following:

As indicated above and in the prior rejection, Shteyn does not explicitly disclose a game subsystem. It would be impractical for Shteyn to list every possible electronic

device or subsystem that can be coupled to a control subsystem.

August 23, 2006 Office Action at page 3. The Applicants once again note that Shteyn listed (1) one or more display devices, (2) one or more VCR's, (3) one or more TV tuners, (4) one or more radio tuners, (5) one or more audio amplifiers, (6) one or more DVD players, (7) a CD jukebox, (8) a digital video camera, and **even** (9) a home security system. As shown above, Shteyn found it "practical" to list a whole litany of home electronic subsystems, including even a "home security subsystem." Clearly, if Shteyn had contemplated an electronic game sub-system, such as an electronic dart game machine, Shteyn would have listed it among the long litany of sub-systems noted above. Shteyn **never** mentions, however, that the sub-system can be **any** sub-system, nor does it disclose that the sub-system can be an electronic game sub-system, in general, or an electronic dart game machine, in particular.

As detailed above, Shteyn does not teach or suggest a game subsystem as recited in claims 1, and 18. Additionally, Shteyn does not teach or suggest providing "game functionality," as recited in claims 1, 11, and 18. At least for these reasons, Shteyn does not render claims 1-3, 5-8, 10, 11, 13, 14, 16, and 17 unpatentable.

II. The Proposed Combination Of Shteyn And Miguel Does Not Render Claims 4, 9, 12, 15, And 18-20 Unpatentable

The Office Action attempts to combine Shteyn with Miguel to render claims 4, 9, 12, 15, and 18-20 unpatentable. The Office Action states the following:

The primary reference Shteyn provides that a single control means can control the operation and functionality of numerous other electronic devices and subsystems without conflict wherein multiple digital resources can be interrelated and integrated into a single entertainment

system (column 1, lines 23-33). The Miguel reference was introduced to demonstrate that it would have been obvious to integrate an electronic dart game as part of the control subsystem as claimed. Miguel discloses that “as the choice of games to play on electronic dart machines has continued to increase, the user interface necessary to permit selection and set-up of those games has become more complicated and burdensome for the player (column 2, lines 37-40).” Therefore, Miguel teaches that a need exists to control the functionality of a plurality of electronically scored amusement games, including video games, pinball machines, and other (column 3, lines 5-12). Therefore, the teaching of the references as a whole and exemplified portions pointed to above would have lead one of ordinary skill in the art at the time of the invention to combine the references as taught.

August 23, 2006 Office Action at page 4.

Initially, Miguel at column 2, lines 37-40 states the following: “Also, as the choice of games to play on electronic dart machines has continued to increase, the user interface necessary to permit selection and set-up of those games has become more complicated and burdensome for the player.” Notably, this portion is referring to a single dart machine. A single dart machines allow a user to play numerous **dart** games, such as cricket, 501, dart baseball, and the like. Because a single dart game system allows a user to play a wide variety of particular dart contests, the user interface may be complicated (e.g., including plurality of buttons, switches, and the like). The only idea this portion of Miguel suggests is that some dart game user interfaces are complicated.

Next, Miguel at column 3, lines 5-18 states the following:

The invention is particularly adapted to implementation of leagues and tournaments that utilize electronic dart machines, although it will be appreciated that many of the features of the invention are applicable to electronically scored amusement games in general, including video games, pinball machines, and others. League information,

including team and player information, is shared between the league machine and dart machines so that the dart machines can utilize the league information for various purposes such as permitting player and team identification via a menu driven user interface, automatically controlling the selection and setup of games, controlling player rotation, and automatically implementing player handicaps.

Thus, Miguel discloses a league machine that share information with a plurality of dart machines. The league machine is not connected to a jukebox subsystem, or another control system that exerts control over a jukebox subsystem. Further, even if the proposed combination of references was proper, it would only result in a control system of Shteyn controlling home theater sub-systems, such as VCRs, DVD players, and the like, and a plurality of dart machines that are in communication with a separate "league machine."

The proposed combination, however, does not teach or suggest "a **single control subsystem** coupled to the dart game subsystem and the jukebox subsystem, the control subsystem and the dart game subsystem providing game functionality, and the jukebox subsystem and the control subsystem providing jukebox functionality, the control subsystem exercising control over the dart game subsystem **and** the jukebox subsystem," as recited, for example, in claim 4. Thus, for at least this reason, the proposed combination of Shteyn and Miguel does not render claims 4, 9, 12, 15, And 18-20 unpatentable.

As noted above, the Office Action attempts to pick the dart game machine of Miguel, which is in communication with a "league machine," and combine it with the system of Shteyn that includes a separate control system that is in communication with home theater components and home security systems.

Further, the Office Action attempts to combine Miguel with Shteyn to reject claims 4, 9, 12, and 15 by stating the following:

It would have been obvious for one of ordinary skill in the art at the time of applicant's invention to incorporate Miguel's electronic dart game functionality as an electronic subsystem as disclosed in Shteyn, in order to minimize the overall number of system components necessary to provide entertainment.

See Office Action at page 5. The Office Action uses the same rationale to reject claims 18-20.

As noted above, Shteyn discloses a control system connected to a variety of home theater components, or a security system, **but not a game subsystem**. Miguel, on the other hand, discloses a plurality of dart machines in communication with a separate "league machine." The league machine is not in communication with anything other than dart machines. There is nothing in Miguel or Shteyn that suggests that an isolated dart game machine may be controlled by a single system that also controls a jukebox subsystem. Just because Miguel discloses a dart league machine in communication with a plurality of dart machines does not mean that it can be combined with the system of Shteyn to produce the inventions recited in claims 4, 9, 12, 15, and 18-20.

It is not enough to merely pick an isolated dart machine, which is in communication with a league machine from Miguel and attempt to shoehorn it into a system disclosed by Shteyn to produce the inventions recited in claims 4, 9, 12, 15, and 18-20. Merely identifying isolated elements in the prior art is not enough to establish a *prima facie* case of obviousness:

[M]ere identification in the prior art of each element is insufficient to defeat the patentability of the combined

subject matter as a whole. [*In re Rouffet*, 149 F. 3d 1350] at 1355, 1357 [(Fed. Cir. 1998)]. Rather, to establish a prima facie case of obviousness based on a combination of elements disclosed in the prior art, the Board must articulate the basis on which it concludes that it would have been obvious to make the claimed invention. *Id.* In practice, this **requires** that the Board “explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.” *Id.* at 1357-59. This entails consideration of both the “**scope and content of the prior art**” and “level of ordinary skill in the pertinent art” aspects of the Graham test.

When the Board does not explain the motivation, or the suggestion or teaching, that would have led the skilled artisan at the time of the invention to the claimed combination as a whole, we infer that the Board used hindsight to conclude that the invention was obvious. *Id.* at 1358.

See in re Kahn, 441 F.3d 977 (Fed. Cir. March 22, 2006) (emphasis added).

While the Office Action has attempted to show a motivation to combine Shteyn and Miguel, the proposed combination, as noted above, does not produce the inventions recited in claims 4, 9, 12, 15, and 18-20. Attempting to take only one small portion of Miguel (e.g., a dart machine) and combine it with the system disclosed in Shteyn, however, does not take account of the references in their entireties. Thus, for at least this reason, the Applicants respectfully submit that the proposed combination does not render these claims unpatentable.

III. Incorporating A Game Subsystem And Jukebox Subsystem Into A Single Unit Is Not Merely A Matter Of Engineering Design Choice

The Applicants next turn to the rejection of claims 18-20. Initially, the Applicants note that these claims should be in condition for allowance, at least for the reasons discussed above. Claim 18 of the present application recites the following:

An entertainment system, comprising:

a single unit;

a game subsystem within the single unit;

a jukebox subsystem within the single unit; and

a single control subsystem within the single unit, the control subsystem being coupled to the game subsystem and the jukebox subsystem, the control subsystem and the game subsystem providing game functionality, and the jukebox subsystem and the control subsystem providing jukebox functionality.

Thus, as clearly shown above, the game subsystem and the jukebox subsystem are **both within the single unit**. That is, the single unit contains both subsystems.

The Office Action states that “Shteyn expressly indicates that a ‘CD jukebox’ can be integrated with other electronic devices and subsystems (column 4, lines 5-9).” *See* August 23, 2006 Office Action at page 4. This portion of Shteyn, however, states the following:

In a home theater environment, sub-systems 102-106 each comprise, for example, any of a one or more display devices, one or more VCR’s, one or more TV tuners, one or more radio tuners, one or more audio amplifiers, one or more a [sic] DVD players, CD jukebox, digital video camera, a home security system, etc.

Shteyn at column 4, lines 4-9. This passage merely states that the sub-systems may “comprise” the various devices. Nowhere does Shteyn state that a plurality of such devices are “within a single unit.” Indeed, Shteyn clearly does not mean that a digital video camera and a home security system are both contained within a single unit.

The Office Action also states “Miguel also provides that a single unit can house an electronic dart game, cricket, monitor, upper display, IR unit, etc.” *See* August 23, 2006 Office Action at pages 4-5. However, these components are all part of the same dart game machine. Of course an electronic dart game machine includes a housing that contains all the components of that machine, e.g., a monitor, dartboard, etc. The Applicant notes that “cricket” is merely one type of dart game to be played on a dart game machine, not a separate physical component of the machine. Miguel clearly does not teach or suggest, however, a single unit housing anything other than a dart game system. Neither Shteyn or Miguel teach or suggest a single unit that houses **both** a jukebox subsystem and a dart game subsystem.

The proposed combination of Shteyn and Miguel unquestionably does not teach or suggest a game subsystem and a jukebox subsystem within a single unit, as recited in claims 18-20. The Office Action, however, asserts that “it has been well settled that by providing a single unit or housing for making integral structures disclosed in the prior art would be merely a matter of obvious engineering choice.” *See* August 23, 2006 Office Action at page 8.

Claim 18 recites a “single unit” that houses (1) the game subsystem, (2) the jukebox subsystem, and (3) the control subsystem. **All three subsystems are housed within a single unit.** The Applicant respectfully submits that housing the game

subsystem and the jukebox subsystem in a single unit is not merely a matter of obvious design choice.

First, such game systems and jukebox systems are not normally linked to one another. Indeed, even the Office Action cannot cite a single example of a prior art reference that discloses a system in which a game system is linked to a jukebox system.

Next, the background of the present application clearly discusses the disadvantages of numerous game machines having separate housings. Overall, there has been a need for maximizing the floor space within an establishment, and to reduce the number of operational gaming systems in an establishment, as described in the background section of the present application. *See, e.g.*, present application at ¶¶ [0005 – 0006] (“Electronic entertainment devices and jukeboxes, however, **occupy valuable floor space** that could otherwise be profitably used, for example, for additional customer seating.... **Reducing the number of operational gaming systems in an entertainment establishment may in many instances reduce overall operating expenses**”). Housing a gaming system and a jukebox system into a single unit addresses these needs, and should therefore be patentable. *See Shenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed.Cir. 1983).

The cases on which the Office Action relies, *In re Larson* and *In re Wolfe*, are inapplicable to the Applicants’ claims. In *Larson*, the court rejected a claim to a one-piece handle for a massage device because the prior art disclosed a handle for a massage device that was the same except that the prior art handle consisted of two pieces fastened together. *See In re Larson*, 144 USPQ 347 (C.C.P.A. 1965) (holding “merely making a two-piece handle in one piece is not patentable invention because it is an obvious thing to

do if deemed desirable”). In *Wolfe*, the court rejected a claim to a “brake drum integral with a said clamping means” because “the term ‘integral’ is not limited to a fabrication of the parts from a single piece of metal, but is inclusive of other means for maintaining the parts fixed together as a single unit.” See *In re Wolfe*, 116 USPQ 443 (C.C.P.A. 1958) (“While the brake disc and clamp of [the prior art] comprise several parts, they are rigidly secured together as a single unit. The constituent parts are so combined as to constitute a unitary whole.”)

Claims 18-20 are not directed to components fabricated from a single piece of material that have been previously joined to one another through some other means, as in the cases relied upon in the Office Action. Claims 18-20 are directed to a single unit that comprises a game subsystem, a jukebox subsystem, and a single control subsystem, **which have never before been contained within a single unit**. In other words, the term “single unit,” is not directed to the manner in which the components of the single unit are fastened or connected to one another. Rather, the term “single unit” is directed to the very idea of bringing the components together in the first instance. Thus, neither *In re Larson* nor *In re Wolfe*, are applicable to claims 18-20. Thus, at least for these reasons, claims 18-20 should be in condition for allowance.

IV. Conclusion

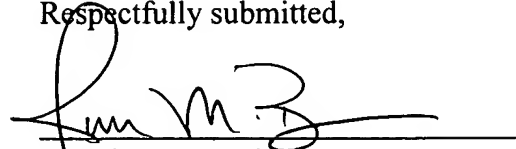
The Applicants respectfully submit that claims 1-20 of the present application should be in condition for allowance for at least the reasons discussed above and request reconsideration of the claim rejections. If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the undersigned attorney. The Commissioner is authorized to charge any necessary fees or credit any

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overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J. M. Butscher", is written over a horizontal line.

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